

Appl. No. : 09/231,415  
Filed : January 14, 1999

apparent reason why Applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application that matured into a patent.

Double Patenting Claim Rejections Appear to be an *In re Schneller* Rejection

According to Section 804(II)(B) of the MPEP, there are three types of non-statutory double patenting claim rejections: "Obviousness-Type", applications with the particular set of facts set forth in *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968), or utility applications filed with another design or plant patent.

The Examiner has not specified the type of non-statutory double patenting claim rejection relied upon. However, it appears that the Examiner used *In re Schneller* to reject the claims because the Examiner cites "397 F.2d 350, 158 USPQ 210 (CCPA 1968)", the citation for *In re Schneller*, as the basis for the rejection of the claims. Further, the Examiner uses form Paragraphs 8.38 from M.P.E.P. §804 (II)(B)(2) which is the section entitled "Another Type of Non-Statutory Double Patenting Rejection" and which is based on the *In re Schneller* case.

The *In re Schneller* Rejection of Claims is Improper

An *In re Schneller* rejection is limited to the particular set of facts in that case. According to Section 804(II)(B)(2) of the M.P.E.P.:

"The decision in *In re Schneller* did not establish a rule of general application and thus is limited to the facts set forth in that decision."

Further, Section 804(II)(B)(2) of the M.P.E.P. states that:

"Non-statutory rejections based on will be rare. The Technology Center (TC) Director must approve any nonstatutory double patenting rejections based on *Schneller*. If an examiner determines that a double patenting rejection based on *Schneller* is appropriate in his or her application, the examiner should first consult with his or her supervisory patent examiner (SPE). If the SPE agrees with the examiner then approval of the TC Director must be obtained before such a nonstatutory double patenting rejection can be made."

The Applicant respectfully submits that the application does not fit the particular facts of *In re Schneller*. Furthermore, the Examiner has not stated why this application fits within the particular facts of *In re Schneller*. Moreover, there is no indication in the Office Action that the procedural safeguards stated in Section 804(II)(B)(2) of the M.P.E.P., such as consultation with

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the supervisory patent examiner and obtaining the approval of the Technology Center (TC) Director, were followed.

Therefore, the Applicant respectfully submits that the *In re Schneller* rejection of claims is improper.

### CONCLUSION

For all the foregoing reasons, Applicant respectfully requests withdrawal of all rejections under non-statutory double patenting, and allowance of the pending application.

Applicant has endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. In light of the above remarks, reconsideration and withdrawal of the outstanding rejection is respectfully requested. If the Examiner finds any remaining impediment to the prompt allowance of these claims that could be clarified with a telephone conference, the Examiner is respectfully requested to initiate the same with the undersigned.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

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